

REMARKS

Claims 1-34 remain in this application. Claims 1-34 are rejected. Claims 1-3, 5-9, 11-16, 19-21, 23-27 and 29-32 are amended herein to clarify the invention, to broaden language as deemed appropriate and to address matters of form unrelated to substantive patentability issues.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims cited in the above-referenced Office Action.

Claims 7, 9, 25 and 27 are rejected under 35 U.S.C. § 112, first paragraph, as not being enabled by the specification. Applicants herein respectfully traverse this rejection. The Office Action states that description of the intermediate layer at present allegedly does not permit one skilled in the art to use the invention. In response to such assertion, Applicants respectfully submit that Fig. 5 depicts a side view of a tape roll, and an intermediate layer of circular shape positioned to overlay a side of the tape roll, as sufficiently described in the specification as filed. The Examiner's attention is drawn to the spiral dotted representation of the rolled-up tape, indicating that the circular intermediate layer overlays a side of the roll, and is in front of the roll as viewed by the observer of Fig. 5, and hence the spiral of the tape roll, behind the intermediate layer, is shown with broken lines. The reference designator 10 identifies this circularly shaped intermediate layer, a plane of which

is aligned parallel with a side plain of the roll of tape. To prevent any potential confusion regarding what is defined by the term "folded side," claim 1 is amended to define a "folded edge of the tape" and claims 7, 9, 25 and 27 now recite that the intermediate layer is provided at least on a side of the roll at which the folded edge of the tape is disposed.

Applicants respectfully submit that one skilled in the art would readily be able to implement the present invention without undue experimentation as now claimed, based on a reading of the specification as filed. Therefore, reconsideration of the rejection of claims 7, 9, 25 and 27 is earnestly solicited.

Claims 1-3, 5, 6, 10-12, 14-16, 19-21, 23, 24 and 28-32 are rejected as obvious over Vitale (US 4,792,473) in view of Hibler (US 6,001,200) and Tuoriniemi (US 6,444,307) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

It is respectfully submitted that a *prima facie* case of obviousness could not be established in rejection of amended claims 1-3, 5, 6, 10-12, 14-16, 19-21, 23, 24 and 28-32. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must

be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

In the present instance, the proffered combination of references does not teach or suggest all claim limitations of either of independent claims 1 and 19, and the rejected claims dependent therefrom.

With regard to independent claim 1, the claim recites that a lateral longitudinal section of the tape includes perforations formed at least through the backing layer and the adhesive layer of the tape, and wherein a central region of the tape is free of such perforations. Applicants submit that this teaching is lacking in each and every cited reference. Vitale, the only reference of the combination which teaches perforations of any kind, discloses exclusively disposing the perforations at a central location, and not at a lateral position of the tape. Furthermore, the perforations are not formed through the adhesive, but rather where the adhesive is absent. The other two references, Hibler and Tuoriniemi, fail to provide this noted feature missing from Vitale.

Similarly, with regard to the claimed subject matter of independent claim 19, the combination of references fails to disclose all claimed features. For example,

claim 19 recites that the tape is folded along a slit formed in the protective film, wherein the slit is disposed along a line between a non-adhering central strip and an adjoining region of the adhesive layer. It is respectfully submitted that each of the cited references is silent regarding such specific placement of a slit in the protective film. As disclosed in the second full paragraph of the substitute specification on page 7, this feature “is particularly advantageous for gluing joints between two structural elements, which adjoin one another at right angles, since skewed or shifted gluing especially in the contact area of structural elements is prevented by these means in a simple manner. Nevertheless, the adhesive tape ensures that the joint is sealed and closed off reliably even over edges and corners, since the two outer edge, adhesive regions of the tape are sufficiently wide and therefore glued only on flat surfaces.”

Based upon the above, applicants respectfully submit that the proffered combination of references fails to teach or suggest all claim limitations of claims 1 and 19 as properly required for establishing a *prima facie* case of obviousness. The remaining claims depending from these claims derive patentability therefrom, as well as for the additional recitations they contain. Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references. Reconsideration of the rejection of claims 1-3, 5, 6, 10-12, 14-16, 19-21, 23, 24 and 28-32 and their allowance are respectfully requested.

Claims 1-3, 5, 6, 10-16, 19-21, 23, 24 and 28-32 are rejected as obvious over Loscuito (US 5,264,775) in view of Hibler (US 6,001,200) and Tuoriniemi (US 6,444,307) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection.

As argued above with respect to the Vitale reference, Loscuito, although teaching perforations, is also deficient regarding teaching relating to restricting such perforations to a laterally disposed longitudinal region, as claimed in claim 1. Therefore, applicants respectfully submit that the proffered combination of references fails to teach all claim limitations of claim 1.

Similarly, none of the references teach or suggest the claimed feature of claim 19 discussed above herein, in accordance with which the tape is folded along a slit formed in the protective film which is specifically disposed along a line between a non-adhering central strip and an adjoining region of the adhesive layer.

Based upon the above, applicants' respectfully submit that the proffered combination of references fails to teach or suggest all claim limitations of claims 1 and 19 as properly required for establishing a *prima facie* case of obviousness. The remaining claims depending from these claims derive patentability therefrom, as well as for the additional recitations they contain. Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references. Reconsideration of the rejection of claims 1-3, 5, 6, 10-16, 19-21, 23, 24 and 28-32 and their allowance are respectfully requested.

Claims 4 and 22 are rejected as obvious over either Vitale or Loscuito, in view of Hibler and Tuoriniemi, and further in view of Porter et al. (US 5,895,301) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection.

It is respectfully submitted that the Porter et al. reference fails to provide what is missing in each of the remaining references in either of the combinations based upon Vitale or Loscuito, as discussed above with respect to the rejections of the respective base claims. Thus, the combination of references fails to teach or suggest all the claim limitations. Therefore, reconsideration of the rejection of claims 4 and 22 and their allowance are respectfully requested.

Claims 8, 17, 18, 26, 33 and 34 are rejected as obvious over either Vitale or Loscuito, in view of Hibler and Tuoriniemi, and further in view of Avery (US 2,373,092), Blok et al. (US 6,177,163) and Samuelson (5,736,001) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection.

It is respectfully submitted that none of the Avery, Blok et al. And Samuelson references provide what is missing in each of the remaining references, in either of the combinations based upon Vitale or Loscuito, as discussed above with respect to the rejections of the respective base claims. Thus, the combination of references fails to teach or suggest all the claim limitations. Therefore, reconsideration of the rejection of claims 8, 17, 18, 26, 33 and 34 and their allowance are respectfully requested.

Applicants respectfully request a one (1) month extension of time for responding to the Office Action. Please charge the fee of \$110 for the extension of time to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,
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